

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.116 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claims 17-26, 28-30 and 33-37 have been canceled without prejudice or disclaimer. In light of the cancellation of independent claim 17, claim 32 has been amended to be in independent form. In view of the fact that the Patent Office has previously conducted a search and has considered the subject matter of claim 32, it is believed that the above amendments do not give rise to any new issues which would require further search and/or consideration by the Examiner. Entry of the above amendments is proper at least because they are effective to place the application either in condition for allowance or in better form for appeal. See M.P.E.P. § 714.12.

In the Official Action, claims 17, 24, 25, 29, 30 and 35-37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,133,363 (*Guirguis*). Claims 18, 19 and 22 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Guirguis* in view of U.S. Patent No. 4,714,680 (*Civin*). Claim 20 stands rejected under 35 U.S.C. § 103(a) as being obvious over *Guirguis* in view of *Civin*, and further in view of U.S. Patent No. 5,686,281 (*Roberts*). Claim 21 stands rejected under 35 U.S.C. § 103(a) as being obvious over *Guirguis* in view of U.S. Patent No. 5,399,580 (*Daluge*). Claims 23, 26, 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Guirguis* in view of *Civin*, and further in view of U.S. Patent No. 6,099,730 (*Ameer et al*). Claim 28 stands rejected under 35 U.S.C. § 103(a) as being obvious over *Guirguis* in view of International Publication No. WO 00/68689 (*WO '689*). These rejections are moot in light of the above cancellation of

claims 17-26, 28-30 and 33-37 and as such, withdrawal of the rejections is respectfully requested.

Claim 32 stands rejected under 35 U.S.C. § 103(a) as being obvious over *Guirguis* in view of U.S. Patent No. 7,006,858 (*Silver et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Guirguis does not disclose or suggest each feature recited in independent claim 32. For example, as acknowledged at page 11 of the Official Action, *Guirguis* does not disclose or suggest a step of implanting the assembly recited in claim 32 in a biological organism. There is simply no disclosure or suggestion of such feature.

Silver et al fails to cure the above deficiencies of *Guirguis*. In this regard, the Patent Office has relied on *Silver et al* for disclosing "the implementation of a sensor within a blood vessel, wherein the sensor is an immunosensor" (Official Action at page 11). However, absent an improper resort to Applicants' own disclosure, one of ordinary skill in the art would not have been motivated to modify *Guirguis* by implanting the fluid sample container thereof in a biological organism.

In this regard, it is well established that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01(VI). Moreover, "[i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01(V).

In the present case, Applicants note that *Guirguis* relates to medical and laboratory specimen collecting and testing equipment (col. 1, lines 14-15). *Guirguis* discloses various

issues which may arise in the collection, transport and shipment of biological fluid specimens (col. 1, line 19 to col. 2, line 20). As can be seen from Figures 1-4 and the accompanying description set forth in *Guirguis*, the container disclosed by *Guirguis* is specifically designed for the storage and transport of bodily fluids. This is apparent from the following disclosure at the paragraph bridging columns 5 and 6 of *Guirguis* which discusses the operation of the container:

The shuttle resin/sample container 70 is pushed down until it enters into the body cavity 33 at which time the lower O-ring 64 engages stop rib 36 thus seating the shuttle resin/sample container 70 in a predetermined position so that it cannot break or damage the shuttle storage unit 30. When the shuttle resin/sample container 70 is seated in the shuttle storage unit 30, the upper "O" ring 62 becomes engaged with the inner surface 25 of cylindrical body 24. This will discontinue the communication between the body cavity 53 and the atmosphere through the air release aperture 56. Consequently the fluid entering the body cavity 53 will be trapped inside it even after removal of the shuttle storage unit 30 together with the seated resin/sample container 70.

It is apparent from the above disclosure and the patent as a whole that the device disclosed by *Guirguis* is directed to a container for the storage and transport of bodily fluids. While *Silver et al* discloses the use of a sensor within a blood vessel, this disclosure would not have motivated one of ordinary skill in the art to implant the container disclosed by *Guirguis* in a biological organism. Quite clearly, implanting such container intended and designed for the storage and transport of bodily fluids, in a biological organism would change the principle of the operation of the container and render such container unsatisfactory for its intended purpose.

For at least the above reasons, it is apparent that no *prima facie* case of obviousness has been established with respect to claim 32. Accordingly, withdrawal of the above § 103(a) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By: 

Roger H. Lee

Registration No. 46317

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620